

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Application No.:	10/558,476	Confirm. No.:	3734
Filing Date:	January 10, 2007	Examiner:	Daniel WALSH
First Inventor:	Claus DIETZE	Art Unit:	2887
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For:	CHIP CARD WITH AT LEAST ONE APPLICATION		

APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

INTRODUCTORY COMMENTS

This is an appeal brief filed pursuant to the appellant's appeal to the Board of Patent Appeals and Interferences from the final rejection of claims 1-11 in the above-identified application.

I. REAL PARTY OF INTEREST

The real party of interest is the assignee of record: Giesecke & Devrient GmbH.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

a. Status of claims in proceeding

Claims 1-11 are currently pending.

Claims 1-3 and 6-8 are currently rejected under 35 U.S.C. § 102(b) as being anticipated by WO 00/69183 (*Vilppula*).

Claims 5 and 9-11 are currently rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 00/69183 (*Vilppula*).

b. Identification of claims on appeal

Claims 1-11 are currently appealed herein.

Claim 1 is an independent claim, and claims 2-9 depend from claim 1.

Claim 10 is an independent claim, and claim 11 depends from claim 10.

IV. STATUS OF AMENDMENTS

There are no outstanding amendments to the claims. The most recent amendment was filed on October 9, 2009 and subsequently entered by the examiner.

V. SUMMARY OF CLAIMED SUBJECT MATTER

For the purposes of appeal, the rejection of independent claims 1 and 10 are appealed. The patentability of dependent claims 2-9 will rise or fall based on the determination of the patentability of claim 1. The patentability of dependent claim 11 will rise or fall based on the determination of the patentability of claim 10.

A. Claim 1

A chip card (1) comprises at least one application for which an implementation (4) and an entry (5) referring to the implementation (4) are present on the chip card (1). A plurality of entries (5) referring to the same implementation (4) are present on the chip card (1). The implementation (4) has a plurality of applications associated therewith, with a separate entry (5) being present for each application and the implementation (4) is executed in different ways depending on which entry (5) the implementation (4) starts with (Fig.; para. [0013]; p. 4, ll. 10-23).

B. Claim 10

A method for executing an application available on a chip card (1), comprises the steps of evaluating one of a plurality of entries (5) present on the chip card (1) and referring jointly to a same implementation (4) of the application on the chip card (1). The implementation (4) has a plurality of applications associated therewith with a separate entry (5) present for each application. The implementation (4) is executed different ways depending on which entry (5) the implementation starts (4) with (Fig.; para. [0013]; p. 4, ll. 10-23).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-3 and 6-8 are currently rejected under 35 U.S.C. § 102(b) as being anticipated by WO 00/69183 (*Vilppula*).

Claims 5 and 9-11 are currently rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 00/69183 (*Vilppula*).

The rejection of claims 1 and 10 are currently appealed herein.

VII. ARGUMENT

A. Overview

Claims 1-3 and 6-8 are currently rejected under 35 U.S.C. § 102(b) as being anticipated by WO 00/69183 (*Vilppula*).

Claims 5 and 9-11 are currently rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 00/69183 (*Vilppula*).

The rejection of claims 1 and 10 are currently appealed herein.

It is submitted that *Vilppula* fails to disclose or suggest every limitation required by each of independent claims 1 and 10. Accordingly, reversal of the rejection of claims 1 and 10 is requested, as well as the rejection of claim 2-9 and 11 which depend from claims 1 and 10, respectively.

B. Pertinent Law on Anticipation

Anticipation under 35 U.S.C. § 102(b) is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention. See, for example, *In re Paulsen*, 30 F.3d 1475, 1480-1481, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994) and *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990).

Unpatentability based on "anticipation" requires that the invention is not in fact new. See, e.g., *Hoover Group, Inc. v. Custom Metalcraft, Inc.*, 66 F.3d 299, 302, 36 USPQ2d 1101, 1103 (Fed. Cir. 1995) ("lack of novelty (often called "anticipation") requires that the same invention, including each element and limitation of the claims, was known or used by others before it was invented by the patentee").

Anticipation requires that a single reference describe the claimed invention with sufficient precision and detail to establish that the subject matter existed in the prior art. See, e.g., *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990) ("the reference must describe the applicant's claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it").

The dispositive question regarding anticipation is whether one skilled in the art would reasonably understand or infer from the prior art reference's teaching that every claim limitation was described in that single reference. *Akamai Technologies Inc. v. Cable & Wireless Internet Services Inc.*, 344 F.3d 1186, 1192, 68 USPQ2d 1186, 1190 (Fed. Cir. 2003); *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 1368, 66 USPQ2d 1801, 1809 (Fed. Cir. 2003).

Although claims are to be given their "broadest reasonable construction," any construction of the claims must be "consistent with the specification...and that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Bond*, 910 F.2d 831, 833, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990)(quoting *In re Sneed*, 710 F. 2d 1544, 1548, 218 U.S.P.Q. 385 (Fed. Cir. 1983)).

C. Pertinent Law on Obviousness

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), *viz.*, (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the art.

The scope and content of the prior art, and the level of ordinary skill in the art may be evidenced by the prior art references. *In re GPAC Inc.*, 57 F.3d 1573, 1579, 35 USPQ2d 1116, 1121 (Fed. Cir. 1995); *see also In re Oelrich*, 579 F.2d 86, 91, 198 USPQ 210, 214 (CCPA 1978).

The examiner bears the initial burden of presenting a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d, 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). In order to establish a *prima facie* case of obviousness, the examiner must show that each and every limitation of the claim is described or suggested by the prior art or would have been obvious based on the knowledge of those of ordinary skill in the art. *See Fine*, 837 F.2d at 1074, 5 USPQ2d at 1598.

Furthermore, “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’.... [H]owever, the analysis need

not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)). Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444; *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

D. Claim 1

Claim 1 of the pending application requires a chip card having at least one application for which an implementation is provided. Claim 1 recites that the chip card has a plurality of entries which are associated with the same implementation, such that a plurality of applications is associated with a single implementation, and a separate entry is provided for each application.

From these features of the chip card, it is clearly understood that claim 1 requires an executable implementation as well as a plurality of applications and entries associated with this executable implementation. The skilled person would recognize from these requirements of claim 1 that the executable implementation is executed as an application via the associated entry, whereas the application represents an executed process or runtime-instance of the executable implementation.

1. Brief Description of *Vilppula*

Vilppula teaches a mobile terminal having a SIM card (24) where the SIM card (24) contains a master file (58), a directory (70), a profile selection app (PSA) (60), and separate application profiles (72, 74, 76, 78). The PSA (60) contains the separate application profiles (72, 74, 76, 78) and is used to control access to the applications (see p. 11, ll. 6-12). Once the user selects a profile (user profile), the directory (70) file contains a list of application identifiers (AID) which indicate applications accessible to the user under this user profile (see p. 12, ll. 9-23). The user profile is associated with a particular user through the use of PIN codes to restrict user access to a particular user profile (see p. 13, ll. 10-21).

As understood, an authorization for each individual application is not required, but all applications defined in the user profile are made accessible at once.

According to the rejection, the examiner identifies the implementation, the plurality of applications, and the plurality of entries according to claim 1 with the user profile, the applications, and directory via the application identifiers (AID) of *Vilppula*.

The applicant submits that the examiner's interpretation of *Vilppula* and the correlation of these features in *Vilppula* to the required features of claim 1 are in error. It is therefore asserted that *Vilppula* does not disclose or suggest each of these features in the manner required by claim 1.

2. Reasons for Error in Rejection of Claim 1 as Anticipated by *Vilppula*

- a. *Vilppula* does not teach an implementation that is executed in different ways depending on the beginning entry

The rejection argues that the user profile of *Vilppula* is executed or used differently depending upon which entry the implementation starts with. The applicant respectfully disagrees. Specifically, the user profile of *Vilppula* does not qualify as the implementation required by claim 1.

In general, the user profile of *Vilppula* provides separate environments and selective access rights for different users having access to the same device, such as a mobile phone. *Vilppula* discloses a method to control the access to applications on a storage medium in a manner allows access to an application for which a specific user is authorized is provided to the user (p. 11, ll. 8-9). The user profile of *Vilppula* permits the user with access to a selected number of applications upon presenting the password (p. 3, ll. 1-5).

The user profile of *Vilppula* cannot be considered to be executable by a processor in the sense of an executable implementation, as particularly required by claim 1.

Specifically, *Vilppula* does not teach an implementation that is executed in different ways depending on the beginning entry of a user via the user profile since the user profile does not execute any particular application. The user profile merely provides selective access rights to different applications for different users.

Claim 1 defines a technical connection among the implementation, applications, and entries since each of these features represents a different level of abstraction of a process to

be executed. Particularly, these different levels include executable code, function call with parameters and a process being executed with the parameters passed by the call.

In regard to *Vilppula*, the user profile is not connected to the AIDs and the application in the same technical sense as the implementation of claim 1 since the user profile does not represent executable code that may be executed as an application when called by an AID; the applications are not dependent on the user profile in order to be executed in the sense that a process is being run on the mobile terminal. Instead, the user profile only provides selective access for executing an application via an AID. In short, the access provided by the user profile is independent from the AID or the application.

In contrast, the implementation of claim 1 performs the actual execution of an application. The process performed by the implementation then differs depending on the specific application being run.

From these observations it is submitted that the user profile according to *Vilppula* cannot be construed as the implementation in the chip card according to claim 1.

- b. *Vilppula* does not disclose an association of several entries present on a chip card with the same implementation

Contrary to the assertion in the rejection, *Vilppula* does not disclose an association of several entries present on a chip card with the same implementation.

Vilppula discloses that only one AID is associated with a corresponding implementation, namely the AID associated with the profile of the currently logged in user according to the user profile (p. 13, ll. 1-21; p. 14, ll. 25-27). Thus, while *Vilppula* describes several profiles which may exist that have an AID referring to a certain implementation in common, only one profile is active at any time, since only one user can be logged in at the same time.

Vilppula explains that the AIDs in each directory refer to each executable application. There is a unique association of each implementation with one AID, as can be concluded by examples provided by *Vilppula*. For example, the directory file of a user profile contains four AIDs (see page 12, lines 14-15). The four AIDs refer to the WAP, e-money, UMTS1 and PSA executable applications. As a result, three separate applications execute processes when the user selects the WAP, e-money, and UMTS1 applications. Thus, while *Vilppula*

describes several profiles that have an AID referring to a certain implementation in common, only one profile is active at any time, since only one user can be logged in at the same time.

It will be understood that the implementation according to claim 1 performs the actual execution of the processes associated with a particular application. The system according to *Vilppula* functions differently from the chip card of claim 1. The application programs of *Vilppula* are separate and independent of each other, and the AIDs correspond to these separate application programs. If an application program is made inaccessible in a particular user profile, the AID would not be listed in the directory file and no modification would occur to the underlying file structure. Some portions of the file structure would simply be hidden (see page 12, lines 18-23).

According to claim 1 and the specification, an application connected to the implementation is called by the associated entry (para. [0013]; p. 4, ll. 10-23). The applications associated with the implementation are dependent on one another since they are different in the parameters passed by the associated entries upon calling. Contrariwise, from the foregoing it is understood from the teachings of *Vilppula* that the applications are specified by a certain user profile in a manner independent from one another, and the applications relate to different tasks.

Claim 1 should be interpreted consistent with the specification and the claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. The examiner indicates that the claims have been interpreted in a different way than prescribed by the applicant. It is submitted from the foregoing discussion on the comparison between *Vilppula* and the limitations of claim 1 that the examiner does not interpret the claim limitations in a manner consistent with the specification.

As read in light of the specification and reinforced by the limitations of claim 1, the applications associated with the implementation are in fact dependent upon each other; they are only different by the parameters passed by the associated entries upon being called. Specifically, the specification indicates that "the differences between the applications can be taken into account in the application identifiers" which "influence the manner of execution of the application accessible." This means that the same implementation is executed in different ways and generates different results depending on which application identifier the execution is started from (paragraph [0014]; p. 4, ll. 24-31).

For a better understanding of the limitations of claim 1, the specification provides an example by indicating that if the chip card is inserted into a mobile phone, the memory areas can store authorization information needed for proving a network access authorization. Different memory areas can be addressed in different parameters in the application identifiers and it follows that depending on which application identifier the execution of the implementation is started through, different authorization information is used for providing a network access authorization (paragraph [0014]; p. 5, ll. 7-14).

From this example, the chip card behaves as if a plurality of applications is capable of being implemented with each application having its own authorization information. Yet, the application for proving network access authorization is not actually implemented multiple times, but instead it is done multiple times as a virtual application for proving that a network access authorization is present for each authorization information item (paragraph [0014]; p. 5, ll. 14-20).

From this description in the specification and the foregoing discussion, the skilled person would not understand the entries, application and associated implementation of claim 1 on the basis that it is arranged and they are executed substantially different from features of the system described by *Vilppula*.

In understanding claim 1 from the description in the specification, and the foregoing discussion on *Vilppula*, it is submitted that *Vilppula* fails to teach an implementation associated with a plurality of applications, where separate entries are present for each application and refer to the same implementation.

c. Closing Remarks

From these observations, claim 1 requires a chip card having an executable implementation, as well as a plurality of application and entries associated with the executable implementation. From the limitations of claim 1 and the description in the specification, it is clear that the executable implementation is executed as an application via the associated entry, such that each of the plurality of entries referring to the same implementation represents an individual virtual application associated with the entry, even though only one implementation is present.

From the foregoing, a chip card having every feature required by claim 1 is not taught by *Vilppula* since the user profile does not represent executable code that may be executed as an application when called by an AID, and that the applications specified by a user are independent from one another and related to different tasks. Claim 1 is therefore not anticipated by *Vilppula*.

Reversal of this rejection is kindly requested.

E. Claim 10

Claim 10 is a method claim describing a method for executing an application available on a chip card having a plurality of applications associated with a separate entry present for each application and an implementation executable depending on the entry by which the implementation starts with.

From the foregoing, it is readily apparent that claim 10 includes similar limitations to claim 1, and is a method claim which describes the method for operating the chip card of claim 1. As discussed above, the *Vilppula* reference fails to teach an entry for each implementation of an application in which the implementation has a plurality of applications associated therewith. Moreover, *Vilppula* fails to execute the implementation different ways depending on which entry the implementation starts with.

For the above-discussed reasons associated with claim 1 and claim 10, it is submitted that the skilled person would not understand every features in the method of claim 10 from the teachings of *Vilppula*. Therefore, claim 10 is patentable and non-obvious over *Vilppula*.

Reversal of the rejection is respectfully requested.

VIII. CONCLUSION

For the reasons set forth above, independent claims 1 and 10 of the pending application defines subject matter that is not anticipated or unpatentable within the meaning of 35 U.S.C. § 102(b) and 103(a), respectively.

Reversal of the rejections of claims 1-11 and allowance of these claims are respectfully requested.

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IX. CLAIMS APPENDIX

1. A chip card comprising at least one application for which an implementation and an entry referring to the implementation are present on the chip card, and wherein a plurality of entries referring to the same implementation are present on the chip card, wherein the implementation has a plurality of applications associated therewith, with a separate entry being present for each application and in that the implementation is executed in different ways depending on which entry the implementation starts with.
2. The chip card according to claim 1, wherein the entries referring to the same implementation characterize different virtual applications.
3. The chip card according to claim 1, wherein the entries each contain a freely selectable information sequence.
4. The chip card according to claim 3, wherein the freely selectable information sequences of those entries referring to the same implementation each have a different content.
5. The chip card according to claim 3, wherein the freely selectable information sequences have specifications for execution of the associated implementation.
6. The chip card according to claim 1, wherein the chip card is intended for use in a handset of a mobile phone system.
7. The chip card according to claim 6, wherein a single implementation is present for a plurality of virtual applications for proving a network access authorization.

8. The chip card according to claim 7, wherein an entry is present for each virtual application for proving a network access authorization, the entries referring to the same implementation and wherein a different network access authorization is made available through each entry.
9. The chip card according to claim 8, wherein the entries have different parameters that are evaluated when invoking the virtual applications for proving a network access authorization and effectuate the use of the data belonging to the particular network access authorization.
10. A method for executing an application available on a chip card, comprising the steps: evaluating one of a plurality of entries present on the chip card and referring jointly to a same implementation of the application on the chip card, the implementation having a plurality of applications associated therewith with a separate entry present for each application, and executing said implementation in different ways depending on which entry the implementation starts with.
11. The method according to claim 10, wherein the implementation present on the chip card is executed in different ways depending on which of the entries referring to the implementation is evaluated.

X. EVIDENCE APPENDIX

There are no copies of evidence entered and relied upon in this appeal
of the pending application.

XI. RELATED PROCEEDINGS APPENDIX

There are no related proceedings or decisions rendered by a court or the Board of Appeals in any proceeding identified in the related appeals and interferences section in the pending application.